

**REPLY UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 3621
PATENT
APPLICATION 10/563,187
ATTORNEY DOCKET 1043-005**

REMARKS

Applicant respectfully thanks the Examiner for the consideration provided to this application, and respectfully requests reconsideration of this application.

Each of claims 1, 7, and 14-17 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements, limitations, phrases, terms and/or words implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 1-33 are now pending in this application. Each of claims 1, 14, and 15 is in independent form.

I. The Obviousness Rejections

Each of claims 1-33 was rejected under 35 U.S.C. 103(a) as being obvious, and thus unpatentable, over various combinations of U.S. Patent 5,819,234 ("Slavin"), U.S. Patent 6,856,820 ("Kolls"), U.S. Patent 6,339,384 ("Valdes-Rodriguez"), and/or U.S. Patent 7,044,622 ("Marshall"). Each of these rejections is respectfully traversed.

A. Legal Standards

1. *Prima Facie* Criteria for an Obviousness Rejection

In *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court established factors regarding the factual inquiry required to establish obviousness. The factors include:

1. determining the scope and contents of the prior art;

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2. ascertaining differences between the prior art and the claims at issue;
3. resolving the level of ordinary skill in the pertinent art; and
4. considering objective evidence indicating obviousness or nonobviousness.

The Federal Circuit has applied *Graham's* required factual inquiry in numerous legal precedents that are binding on the USPTO.

It is recognized that most patentable inventions arise from a combination of old elements and often, each element is found in the prior art. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). In *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007), the United States Supreme Court clarified that:

1. “[t]he question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art”;
2. “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art”;
3. it is necessary “to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit”; and
4. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (*quoting In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006).

To establish a *prima facie* case of obviousness, certain criteria must be met. Evidence must be provided that indicates that the combination was obvious to a person with ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007); *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). That evidence must include an apparent reason, with a rational underpinning, to combine the known elements in the fashion claimed in the patent at issue. *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007). There must be a reasonable expectation of success. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.

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Cir. 1991); MPEP 2143. In addition, the prior art reference (or references when combined) must teach... all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143.

Moreover, the "Patent Office has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057, *reh'g denied*, 390 U.S. 1000 (1968). "It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis". *Id.*

It is legal error to "substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results." See, *In re Ochiai*, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

"Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, 'the burden of coming forward with evidence or argument shifts to the applicant.'" *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

2. All Words in a Claim Must Be Considered

"To establish *prima facie* obviousness..., '[a]ll words in a claim must be considered'". MPEP 2143.03, *quoting In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); see also, *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilder*, 429 F.2d 447, 166 USPQ 545, 548 (CCPA 1970); *In re Angstadt*, 537 F.2d 498, 190 USPQ 214, 217 (CCPA 1976); *In re Geerdes*, 491 F.2d 1260, 180 USPQ 789, 791 (CCPA 1974).

3. Unfounded Assertions of Knowledge

Deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* That is, such

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unfounded assertions are not permissible substitutes for evidence. *See, In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

4. The Application of Per Se Rules in Place of Facts

The application of a *per se* rule to reject a claim constitutes legal error because it bypasses the particularized fact-specific inquiry required by 35 USC § 103(a). *See, In re Ochiai*, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

5. Pertinent Prior Art References

The *Graham* analysis requires that, to rely on a prior art reference as a basis for a rejection, the USPTO must show that the reference is “reasonably pertinent to the particular problem with which the invention was involved.” *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664, 57 USPQ2d 1161, 1166 (Fed. Cir. 2000); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1535, 218 USPQ 871, 876 (Fed. Cir. 1983); *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992); *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006).

“References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art.” *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) (“[I]t is necessary to consider ‘the reality of the circumstances,’—in other words, common sense—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor” (*quoting In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979))).

“If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention. If it is directed to a different purpose, the inventor would accordingly have had less

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motivation or occasion to consider it.” *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) (*citing In re Clay*, 966 F.2d 656, 659-60 (Fed. Cir. 1992)).

Yet “[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness.” *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) (*quoting Ecolochem, Inc. v. S. Cal. Edison Co.*, 227 F.3d 1361, 1372 (Fed. Cir. 2000)).

6. Lack of Evidence of Reasons for Combining References

Under the *Graham* analysis, the “examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” MPEP 2142. The requirements for meeting this burden are clear.

To factually support a *prima facie* conclusion of obviousness, an Office Action must provide evidence that indicates that the combination was obvious to a person with ordinary skill in the art. The evidence must include an apparent reason, with a rational underpinning, to combine the known elements in the fashion claimed in the patent at issue. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007) (*quoting In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)).

7. Reasonable Expectation of Success

If all the limitations of a claim are found in a combination of prior art references, ““a proper analysis under § 103 requires, *inter alia*, consideration of ... whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success”” *Medichem, S.A. v. Rolabo, S.L.* (Fed. Cir. February 3, 2006) (*quoting Velander v. Garner*, 348 F.3d 1359, 1363 (Fed. Cir. 2003) (*citing Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966))).

“[T]o have a reasonable expectation of success, one must be motivated to do more than merely to ‘vary all parameters or try each of numerous possible choices until one possibly

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arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful.”” *Medichem, S.A. v. Rolabo, S.L.* (Fed. Cir. February 3, 2006) (*quoting In re O'Farrell*, 853 F.2d 894, 903 (Fed. Cir. 1988)). “Similarly, prior art fails to provide the requisite ‘reasonable expectation’ of success where it teaches merely to pursue a ‘general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it.’” *Id.*

8. Next Office Action

If an Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference will necessarily be factually based on an entirely different portion of that reference, and thus will be legally defined as a “new grounds of rejection.” Consequently, any Office Action containing such rejection can not properly be made final. *See, In re Wiechert*, 152 USPQ 247, 251-52 (CCPA 1967) (defining “new ground of rejection” and requiring that “when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference”), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967) (the USPTO “has the initial duty of supplying the factual basis for its rejection”).

B. Analysis

1. Claim 1

a. Prima Facie Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. The Attempted Application of a Per Se Rule in Place of Facts

The present Office Action alleges, at Page 2:

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the USPTO interprets claim limitations that contain ‘if, may, might, can, when and could’ statement(s), as optional language. As matter of linguistic precision, optional claim elements *do not narrow claim limitations*, since *they can always be omitted* (*In re Johnston*, 77 USPQ2d 1788 (CA FC 2006)). Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does *not* limit the scope of a claim or claim limitation.

Applicant respectfully traverses this attempted application of a *per se* rule as improper and moot in view of the present amendments to claim 1. Claim 1 states, *inter alia*, “transmitting the encrypted unique identifier to a central processor adapted to, responsive to an automatic determination that the unique identifier is associated with a valid financial account, approve the proposed transaction”. Thus, claim 1 does not comprise “optional language”.

c. Lack of Evidence of Obviousness

Applicant respectfully notes that the present Office Action fails to evidence the scope and contents of the prior art as required under *Graham*. The present Office Action fails to even identify what “the pertinent art” is. Moreover, the present Office Action fails to evidence the level of ordinary skill in the pertinent art.

Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103. For at least these reasons, Applicant respectfully requests a reconsideration and withdrawal of the rejection of claim 1.

d. Evidence of Obviousness – Combination of References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Slavin, Kolls, Valdes-Rodriguez, and Marshall, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting

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claim 1, in such a manner so as to arrive at the claimed subject matter of claim 1. Regarding the proffered combination of Slavin, Kolls, Valdes-Rodriguez, and Marshall, the present Office Action states, at Pages 2-4:

1. "it would have been obvious to an ordinary skill in the art at the time the invention was made to modify a method for transmitting a signal from a non-telephonic wireless transmitter/transponder as disclosed by Slavin et al. to include the aspect of a signal is from a *vehicle-powered* non-telephonic wireless transmitter/transponder, as suggested by Kolls et al. to utilize a secure, uninterrupted, long-lasting power connection to the vehicle's battery";
2. "it would have been obvious to an ordinary skill in the art at the time the invention was made to modify a method for transmitting a signal from a *vehicle-powered* non-telephonic wireless transmitter/transponder as suggested by Slavin et al. in view of Kolls et al. to include the aspect of an *encrypted* unique identifier in the transmitted signal as taught by Valdes-Rodriguez to ensure secrecy of information or data during transmission"; and
3. "it would have been obvious to an ordinary skill in the art at the time the invention was made to modify a method for transmitting a signal from a *vehicle-powered* non-telephonic wireless transmitter/transponder as suggested by Slavin et al. in view of Kolls et al. further in view of Valdes-Rodriguez to include the aspect of the signal transmitted responsive to 'a *predetermined input from a user* {claim 1}, *wherein such an input comprises a predetermined number of headlight high beam switch activations within a predetermined time interval*' {claim 6} as suggested by Marshall to activate a transmitter and get it ready to transmit signal/data to a receiver."

Applicant respectfully submits that these unsupported assertions provide no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence is presented that this unsupported assertion was "known in the prior art", as required by *KSR*.

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Applicant reiterates that under *KSR* “rejections on obviousness grounds cannot be sustained by mere conclusory statements”. Thus, the Office Action fails to present the required evidence of obviousness.

e. Marshall is Not Pertinent Art to the Claimed Subject Matter

Included herewith is a Declaration under 37 C.F.R. § 1.132 of Christopher G. de Janasz, an inventor of record of the present application and one skilled in the art of vehicular automation systems as of 21 July 2003, the priority date claimed by the present application.

Paragraphs 17-26 of Mr. de Janasz’s Declaration provide evidence that one skilled in the art would not have found that Marshall is reasonably pertinent to the particular problem with which the invention was involved and non-analogous to the present application. For at least these reasons, a withdrawal of Marshall as a reference in rejecting each of claim 1 is respectfully requested.

f. Reasonable Expectation of Success

The Final Office Action attempts to, impermissibly, combine portions of Slavin, Kolls, Valdes-Rodriguez, and Marshall in rejecting the claimed subject matter.

Applicant respectfully reiterates that Marshall is allegedly directed to an “illumination tool”.

By contrast, Slavin is allegedly directed toward an “automatic toll collection system.” See Abstract.

In further contrast, Kolls’ Abstract allegedly recites an “in-vehicle device data communicates with Internet based data processing resources for the purpose of transacting e-mail, e-commerce, and e-business.”

Further, Valdes-Rodriguez allegedly states, at the Abstract, “device for automatically paying a toll for a vehicle passing through a toll booth.”

The Final Office Action presents no evidence that one having ordinary skill in the art would have had any expectation of success, let alone a reasonable expectation of success, in

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combining the applied portions of the relied-upon references. At most, the applied portions of the relied-upon references provide "only general guidance as to the particular form of the claimed invention or how to achieve it."

Thus, even if there were proper evidence of obviousness presented by the Office Action (an assumption that is respectfully traversed), and even if the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, expressly or inherently teach or suggest every limitation of claim 1 (another assumption that is respectfully traversed), there is still no evidence indicating a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action, and consequently, the Office Action fails to establish a *prima facie* case of obviousness.

g. Conclusion

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 1. Applicant also respectfully requests a withdrawal of each of claims 2-13, each ultimately depending from claim 1.

2. Claim 2

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combination of the applied portions of the relied-upon references no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 2 in such a manner so as to arrive at the additional claimed subject matter of claim 2. Thus, the Office Action fails to present the required evidence of obviousness.

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 2.

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3. Claim 3

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combination of the applied portions of the relied-upon references no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 3 in such a manner so as to arrive at the additional claimed subject matter of claim 3. Thus, the Office Action fails to present the required evidence of obviousness.

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 3.

4. Claim 4

a. Prima Facie Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitation

Claim 4 recites, *inter alia*, yet the applied portions of Slavin fail to teach, “providing an acknowledgment of fulfillment of the proposed transaction to the transmitter.” Instead, the applied portion of Slavin allegedly recites, at col. 9 lines 59-63:

[d]epending on the result of the test at decisional block 200, the toll charge is approved and a green light 34 or the like is activated to indicate a valid toll charging transaction and to signal the motorist (or toll enforcement officials) accordingly.

Applicant respectfully submits that this applied portion of Slavin does not teach, “providing an acknowledgment of fulfillment of the proposed transaction to the transmitter.”

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The applied portions of the other applied references fail to cure at least these deficiencies of the applied portions of Slavin.

Thus, even if there were proper evidence of obviousness presented by the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Evidence of Obviousness – Combination of References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of the applied portions of the relied-upon references no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 4 in such a manner so as to arrive at the additional claimed subject matter of claim 4. Thus, the Office Action fails to present the required evidence of obviousness.

d. Conclusion

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 4.

5. Claim 5

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

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The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of the applied portions of the relied-upon references no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 5 in such a manner so as to arrive at the additional claimed subject matter of claim 5. Thus, the Office Action fails to present the required evidence of obviousness.

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 5.

6. Claim 7

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Slavin, Kolls, Valdes-Rodriguez, Marshall, and Swett, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 7, in such a manner so as to arrive at the claimed subject matter of claim 7. Regarding the proffered combination of Slavin, Kolls, Valdes-Rodriguez, Marshall, and Swett, the present Office Action states, at Page 10:

it would have been obvious to an ordinary skill in the art at the time the invention was made to modify a method for transmitting a signal from a vehicle-powered non-telephonic wireless transmitter/transponder as suggested by Slavin et al. in view of Kolls et al. in view of Valdes-Rodriguez and further in view of Marshall to include the aspect of '*requesting and receiving (i.e., inputting), respectively, a PIN from the user*' as suggested by Swett to confirm the user's identity to a system from which the user requesting approval of the proposed transaction.

Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the

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known elements in the fashion claimed in the patent at issue". Moreover, no evidence is presented that this unsupported assertion was "known in the prior art", as required by *KSR*. Applicant reiterates that under *KSR* "rejections on obviousness grounds cannot be sustained by mere conclusory statements". Thus, the Office Action fails to present the required evidence of obviousness.

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 7.

7. Claim 8

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Slavin, Kolls, Valdes-Rodriguez, Marshall, and Swett, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 8, in such a manner so as to arrive at the claimed subject matter of claim 8. Regarding the proffered combination of Slavin, Kolls, Valdes-Rodriguez, Marshall, and Swett, the present Office Action states, at Page 10:

it would have been obvious to an ordinary skill in the art at the time the invention was made to modify a method for transmitting a signal from a vehicle-powered non-telephonic wireless transmitter/transponder as suggested by Slavin et al. in view of Kolls et al. in view of Valdes-Rodriguez and further in view of Marshall to include the aspect of '*requesting and receiving (i.e., inputting), respectively, a PIN from the user*' as suggested by Swett to confirm the user's identity to a system from which the user requesting approval of the proposed transaction.

Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence is

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presented that this unsupported assertion was "known in the prior art", as required by *KSR*. Applicant reiterates that under *KSR* "rejections on obviousness grounds cannot be sustained by mere conclusory statements". Thus, the Office Action fails to present the required evidence of obviousness.

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 8.

8. Claim 9

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of the applied portions of the relied-upon references no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 9 in such a manner so as to arrive at the additional claimed subject matter of claim 9. Thus, the Office Action fails to present the required evidence of obviousness.

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 9.

9. Claim 10

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of the applied portions of the relied-upon references no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 10 in such a manner so as to arrive at the additional claimed subject

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matter of claim 10. Thus, the Office Action fails to present the required evidence of obviousness.

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 10.

10. Claim 11

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of the applied portions of the relied-upon references no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 11 in such a manner so as to arrive at the additional claimed subject matter of claim 11. Thus, the Office Action fails to present the required evidence of obviousness.

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 11.

11. Claim 12

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of the applied portions of the relied-upon references no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 12 in such a manner so as to arrive at the additional claimed subject matter of claim 12. Thus, the Office Action fails to present the required evidence of obviousness.

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For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 12.

12. Claim 13

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combination of the applied portions of the relied-upon references no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 13 in such a manner so as to arrive at the additional claimed subject matter of claim 13. Thus, the Office Action fails to present the required evidence of obviousness.

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 13.

13. Claim 14

a. Prima Facie Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Lack of Evidence of Obviousness

Applicant respectfully notes that the present Office Action fails to evidence the scope and contents of the prior art as required under *Graham*. The present Office Action fails to even identify what "the pertinent art" is. Moreover, the present Office Action fails to evidence the level of ordinary skill in the pertinent art.

Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103.

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For at least these reasons, Applicant respectfully requests a reconsideration and withdrawal of the rejection of claim 14.

c. The Attempted Application of a Per Se Rule in Place of Facts

The present Office Action alleges, at Page 5:

the USPTO interprets claim limitations that contain ‘if, may, might, can, when and could’ statement(s), as optional language. As matter of linguistic precision, optional claim elements *do not narrow claim limitations*, since *they can always be omitted* (*In re Johnston*, 77 USPQ2d 1788 (CA FC 2006)). Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does *not* limit the scope of a claim or claim limitation.

Applicant respectfully traverses this attempted application of a *per se* rule as improper and moot in view of the present amendments to claim 14. Claim 14 states, *inter alia*, “an output processor adapted to transmit the encrypted unique identifier to a central processor adapted to, responsive to an automatic determination that the unique identifier is associated with a valid financial account, approve the proposed transaction”. Thus, claim 14 does not comprise “optional language”.

d. Evidence of Obviousness – Combination of References

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of Slavin, Kolls, Valdes-Rodriguez, and Marshall, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 14, in such a manner so as to arrive at the claimed subject matter of claim 14. Regarding the proffered combination of Slavin, Kolls, Valdes-Rodriguez, and Marshall, the present Office Action states, at Pages 2-4:

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1. "it would have been obvious to an ordinary skill in the art at the time the invention was made to modify a method for transmitting a signal from a non-telephonic wireless transmitter/transponder as disclosed by Slavin et al. to include the aspect of a signal is from a ***vehicle-powered*** non-telephonic wireless transmitter/transponder, as suggested by Kolls et al. to utilize a secure, uninterrupted, long-lasting power connection to the vehicle's battery";
2. "it would have been obvious to an ordinary skill in the art at the time the invention was made to modify a method for transmitting a signal from a ***vehicle-powered*** non-telephonic wireless transmitter/transponder as suggested by Slavin et al. in view of Kolls et al. to include the aspect of an ***encrypted*** unique identifier in the transmitted signal as taught by Valdes-Rodriguez to ensure secrecy of information or data during transmission"; and
3. "it would have been obvious to an ordinary skill in the art at the time the invention was made to modify a method for transmitting a signal from a ***vehicle-powered*** non-telephonic wireless transmitter/transponder as suggested by Slavin et al. in view of Kolls et al. further in view of Valdes-Rodriguez to include the aspect of the signal transmitted responsive to '***a predetermined input from a user {claim 1}, wherein such an input comprises a predetermined number of headlight high beam switch activations within a predetermined time interval***' {claim 6} as suggested by Marshall to activate a transmitter and get it ready to transmit signal/data to a receiver."

Applicant respectfully submits that these unsupported assertions provide no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence is presented that this unsupported assertion was "known in the prior art", as required by *KSR*. Applicant reiterates that under *KSR* "rejections on obviousness grounds cannot be sustained by mere conclusory statements". Thus, the Office Action fails to present the required evidence of obviousness.

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e. Marshall is Not Pertinent Art to the Claimed Subject Matter

Paragraphs 17-26 of Mr. de Janasz's Declaration provide evidence that one skilled in the art would not have found that Marshall is reasonably pertinent to the particular problem with which the invention was involved and non-analogous to the present application. For at least these reasons, a withdrawal of Marshall as a reference in rejecting each of claim 14 is respectfully requested.

f. Reasonable Expectation of Success

The Final Office Action attempts to, impermissibly, combine portions of Slavin, Kolls, Valdes-Rodriguez, and Marshall in rejecting the claimed subject matter.

Applicant respectfully reiterates that Marshall is allegedly directed to an "illumination tool".

By contrast, Slavin is allegedly directed toward an "automatic toll collection system." See Abstract.

In further contrast, Kolls' Abstract allegedly recites an "in-vehicle device data communicates with Internet based data processing resources for the purpose of transacting e-mail, e-commerce, and e-business."

Further, Valdes-Rodriguez allegedly states, at the Abstract, "device for automatically paying a toll for a vehicle passing through a toll booth."

The Final Office Action presents no evidence that one having ordinary skill in the art would have had any expectation of success, let alone a reasonable expectation of success, in combining the applied portions of the relied-upon references. At most, the applied portions of the relied-upon references provide "only general guidance as to the particular form of the claimed invention or how to achieve it."

Thus, even if there were proper evidence of obviousness presented by the Office Action (an assumption that is respectfully traversed), and even if the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office

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Action, expressly or inherently teach or suggest every limitation of claim 14 (another assumption that is respectfully traversed), there is still no evidence indicating a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action, and consequently, the Office Action fails to establish a *prima facie* case of obviousness.

g. Conclusion

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 14.

14. Claim 15

a. Prima Facie Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. The Attempted Application of a Per Se Rule in Place of Facts

The present Office Action alleges, at Pages 6-7:

the USPTO interprets claim limitations that contain 'if, may, might, can, when and could' statement(s), as optional language. As matter of linguistic precision, optional claim elements *do not narrow claim limitations, since they can always be omitted* (*In re Johnston*, 77 USPQ2d 1788 (CA FC 2006)). Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does *not* limit the scope of a claim or claim limitation.

Applicant respectfully traverses this attempted application of a *per se* rule as improper and moot in view of the present amendments to claim 15. Claim 15 states, *inter alia*, "responsive to an automatic determination that the unique identifier is associated with a valid financial account, automatically transmitting an approval to complete the proposed transaction,

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the proposed transaction involving the valid financial account associated with the unique identifier". Thus, claim 15 does not comprise "optional language".

c. Lack of Evidence of Obviousness

Applicant respectfully notes that the present Office Action fails to evidence the scope and contents of the prior art as required under *Graham*. The present Office Action fails to even identify what "the pertinent art" is. Moreover, the present Office Action fails to evidence the level of ordinary skill in the pertinent art.

Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103. For at least these reasons, Applicant respectfully requests a reconsideration and withdrawal of the rejection of claim 15.

d. Evidence of Obviousness – Combination of References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Slavin, Kolls, Valdes-Rodriguez, and Marshall, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 15, in such a manner so as to arrive at the claimed subject matter of claim 15. Regarding the proffered combination of Slavin, Kolls, Valdes-Rodriguez, and Marshall, the present Office Action states, at Pages 2-4:

1. "it would have been obvious to an ordinary skill in the art at the time the invention was made to modify a method for transmitting a signal from a non-telephonic wireless transmitter/transponder as disclosed by Slavin et al. to include the aspect of a signal is from a *vehicle-powered* non-telephonic wireless transmitter/transponder, as suggested by Kolls et al. to utilize a secure, uninterrupted, long-lasting power connection to the vehicle's battery";

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2. "it would have been obvious to an ordinary skill in the art at the time the invention was made to modify a method for transmitting a signal from a *vehicle-powered* non-telephonic wireless transmitter/transponder as suggested by Slavin et al. in view of Kolls et al. to include the aspect of an *encrypted* unique identifier in the transmitted signal as taught by Valdes-Rodriguez to ensure secrecy of information or data during transmission"; and
3. "it would have been obvious to an ordinary skill in the art at the time the invention was made to modify a method for transmitting a signal from a *vehicle-powered* non-telephonic wireless transmitter/transponder as suggested by Slavin et al. in view of Kolls et al. further in view of Valdes-Rodriguez to include the aspect of the signal transmitted responsive to '*a predetermined input from a user* {claim 1}, *wherein such an input comprises a predetermined number of headlight high beam switch activations within a predetermined time interval*' {claim 6} as suggested by Marshall to activate a transmitter and get it ready to transmit signal/data to a receiver."

Applicant respectfully submits that none of these unsupported assertions provides any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the Office Action fails to present the required **proof** of obviousness.

e. Marshall is Not Pertinent Art to the Claimed Subject Matter

Paragraphs 17-26 of Mr. de Janasz's Declaration provide evidence that one skilled in the art would not have found that Marshall is reasonably pertinent to the particular problem with which the invention was involved and non-analogous to the present application. For at least

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these reasons, a withdrawal of Marshall as a reference in rejecting each of claim 15 is respectfully requested.

f. Reasonable Expectation of Success

The Final Office Action attempts to, impermissibly, combine portions of Slavin, Kolls, Valdes-Rodriguez, and Marshall in rejecting the claimed subject matter.

Applicant respectfully reiterates that Marshall is allegedly directed to an "illumination tool".

By contrast, Slavin is allegedly directed toward an "automatic toll collection system."

See Abstract.

In further contrast, Kolls' Abstract allegedly recites an "in-vehicle device data communicates with Internet based data processing resources for the purpose of transacting e-mail, e-commerce, and e-business."

Further, Valdes-Rodriguez allegedly states, at the Abstract, "device for automatically paying a toll for a vehicle passing through a toll booth."

The Final Office Action presents no evidence that one having ordinary skill in the art would have had any expectation of success, let alone a reasonable expectation of success, in combining the applied portions of the relied-upon references. At most, the applied portions of the relied-upon references provide "only general guidance as to the particular form of the claimed invention or how to achieve it."

Thus, even if there were proper evidence of obviousness presented by the Office Action (an assumption that is respectfully traversed), and even if the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, expressly or inherently teach or suggest every limitation of claim 15 (another assumption that is respectfully traversed), there is still no evidence indicating a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action, and consequently, the Office Action fails to establish a *prima facie* case of obviousness.

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g. Conclusion

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 15. Applicant also respectfully requests a withdrawal of each of claims 16-33, each ultimately depending from claim 15.

15. Claim 16

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of the applied portions of the relied-upon references no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 16 in such a manner so as to arrive at the additional claimed subject matter of claim 16. Thus, the Office Action fails to present the required evidence of obviousness.

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 16.

16. Claim 17

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of the applied portions of the relied-upon references no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 17 in such a manner so as to arrive at the additional claimed subject

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matter of claim 17. Thus, the Office Action fails to present the required evidence of obviousness.

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 17.

17. Claim 18

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of the applied portions of the relied-upon references no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 18 in such a manner so as to arrive at the additional claimed subject matter of claim 18. Thus, the Office Action fails to present the required evidence of obviousness.

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 18.

18. Claim 19

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of the applied portions of the relied-upon references no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 19 in such a manner so as to arrive at the additional claimed subject matter of claim 19. Thus, the Office Action fails to present the required evidence of obviousness.

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For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 19.

19. Claim 20

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combination of the applied portions of the relied-upon references no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 20 in such a manner so as to arrive at the additional claimed subject matter of claim 20. Thus, the Office Action fails to present the required evidence of obviousness.

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 20.

20. Claim 21

a. Prima Facie Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitation

Claim 21 recites, *inter alia*, yet the applied portions of Slavin fail to teach, “transmitting a rejection of the proposed transaction if the proposed transaction exceeds a predetermined amount.” Instead, the applied portion of Slavin allegedly recites, at col. 10, lines 5-13:

[i]f the toll plaza computer detects an invalid tag or a negative balance during an attempt to charge a toll amount, a red light 34 could be flashed or an alarm can be sounded as indicated by software block 206. Moreover, the video camera 37

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which is normally operated at the toll plaza can be used to store images of the plate number and other vehicle data as indicated in block 208 and a violation enforcement procedure may be initiated (see block 210) when and if the toll plaza is equipped to do so.

Applicant respectfully asks, where does this applied portion of Slavin teach any "predetermined amount"? Applicant respectfully submits that this applied portion of Slavin does not teach, "transmitting a rejection of the proposed transaction **if the proposed transaction exceeds a predetermined amount.**"

The applied portions of the other applied references fail to cure at least these deficiencies of the applied portions of Slavin.

Thus, even if there were proper evidence of obviousness presented by the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Evidence of Obviousness – Combination of References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of the applied portions of the relied-upon references no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 21 in such a manner so as to arrive at the additional claimed subject matter of claim 21. Thus, the Office Action fails to present the required evidence of obviousness.

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d. Conclusion

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 21.

21. Claim 22

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitation

Claim 22 recites, *inter alia*, yet the applied portions of Slavin fail to teach, “transmitting a rejection of the proposed transaction if a total amount associated with one or more transactions exceeds a predetermined amount.” Instead, the applied portion of Slavin allegedly recites, at col. 10, lines 5-13:

[i]f the toll plaza computer detects an invalid tag or a negative balance during an attempt to charge a toll amount, a red light 34 could be flashed or an alarm can be sounded as indicated by software block 206. Moreover, the video camera 37 which is normally operated at the toll plaza can be used to store images of the plate number and other vehicle data as indicated in block 208 and a violation enforcement procedure may be initiated (see block 210) when and if the toll plaza is equipped to do so.

Applicant respectfully asks, where does this applied portion of Slavin teach any “predetermined amount”? Applicant respectfully submits that this applied portion of Slavin does not teach, “transmitting a rejection of the proposed transaction if a total amount associated with one or more transactions exceeds a predetermined amount.”

The applied portions of the other applied references fail to cure at least these deficiencies of the applied portions of Slavin.

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Thus, even if there were proper evidence of obviousness presented by the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Evidence of Obviousness – Combination of References

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combination of the applied portions of the relied-upon references no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 22 in such a manner so as to arrive at the additional claimed subject matter of claim 22. Thus, the Office Action fails to present the required evidence of obviousness.

d. Conclusion

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 22.

22. Claim 23

a. Prima Facie Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

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b. Missing Claim Limitation

Claim 23 recites, *inter alia*, yet the applied portions of Slavin fail to teach, “transmitting a rejection of the proposed transaction if the proposed transaction exceeds a predetermined amount for a predetermined counter-party.” Instead, the applied portion of Slavin allegedly recites, at col. 10, lines 5-13:

[i]f the toll plaza computer detects an invalid tag or a negative balance during an attempt to charge a toll amount, a red light 34 could be flashed or an alarm can be sounded as indicated by software block 206. Moreover, the video camera 37 which is normally operated at the toll plaza can be used to store images of the plate number and other vehicle data as indicated in block 208 and a violation enforcement procedure may be initiated (see block 210) when and if the toll plaza is equipped to do so.

Applicant respectfully asks, where does this applied portion of Slavin teach any “predetermined amount”? Applicant respectfully submits that this applied portion of Slavin does not teach, “transmitting a rejection of the proposed transaction if the proposed transaction exceeds a predetermined amount for a predetermined counter-party.”

The applied portions of the other applied references fail to cure at least these deficiencies of the applied portions of Slavin.

Thus, even if there were proper evidence of obviousness presented by the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

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c. Evidence of Obviousness – Combination of References

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combination of the applied portions of the relied-upon references no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 23 in such a manner so as to arrive at the additional claimed subject matter of claim 23. Thus, the Office Action fails to present the required evidence of obviousness.

d. Conclusion

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 23.

23. Claim 24

a. Prima Facie Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitation

Claim 24 recites, *inter alia*, yet the applied portions of Slavin fail to teach, “transmitting a rejection of the proposed transaction if the proposed transaction exceeds a predetermined amount for a predetermined time interval for a predetermined counter-party.” Instead, the applied portion of Slavin allegedly recites, at col. 10, lines 5-13:

[i]f the toll plaza computer detects an invalid tag or a negative balance during an attempt to charge a toll amount, a red light 34 could be flashed or an alarm can be sounded as indicated by software block 206. Moreover, the video camera 37 which is normally operated at the toll plaza can be used to store images of the plate number and other vehicle data as indicated in block 208 and a violation

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enforcement procedure may be initiated (see block 210) when and if the toll plaza is equipped to do so.

Applicant respectfully asks, where does this applied portion of Slavin teach any “predetermined amount” or a “predetermined time interval”? Applicant respectfully submits that this applied portion of Slavin does not teach, “transmitting a rejection of the proposed transaction if the proposed transaction exceeds a **predetermined amount for a predetermined time interval for a predetermined counter-party.**”

The applied portions of the other applied references fail to cure at least these deficiencies of the applied portions of Slavin.

Thus, even if there were proper evidence of obviousness presented by the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Evidence of Obviousness – Combination of References

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combination of the applied portions of the relied-upon references no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 24 in such a manner so as to arrive at the additional claimed subject matter of claim 24. Thus, the Office Action fails to present the required evidence of obviousness.

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d. Conclusion

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 24.

24. Claim 25

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combination of the applied portions of the relied-upon references no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 25 in such a manner so as to arrive at the additional claimed subject matter of claim 25. Thus, the Office Action fails to present the required evidence of obviousness.

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 25.

25. Claim 26

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combination of the applied portions of the relied-upon references no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 26 in such a manner so as to arrive at the additional claimed subject matter of claim 26. Thus, the Office Action fails to present the required evidence of obviousness.

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For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 26.

26. Claim 27

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of the applied portions of the relied-upon references no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 27 in such a manner so as to arrive at the additional claimed subject matter of claim 27. Thus, the Office Action fails to present the required evidence of obviousness.

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 27.

27. Claim 28

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of the applied portions of the relied-upon references no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 28 in such a manner so as to arrive at the additional claimed subject matter of claim 28. Thus, the Office Action fails to present the required evidence of obviousness.

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 28.

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28. Claim 29

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combination of the applied portions of the relied-upon references no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 29 in such a manner so as to arrive at the additional claimed subject matter of claim 29. Thus, the Office Action fails to present the required evidence of obviousness.

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 29.

29. Claim 30

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combination of the applied portions of the relied-upon references no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 30 in such a manner so as to arrive at the additional claimed subject matter of claim 30. Thus, the Office Action fails to present the required evidence of obviousness.

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 30.

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30. Claim 31

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of the applied portions of the relied-upon references no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 31 in such a manner so as to arrive at the additional claimed subject matter of claim 31. Thus, the Office Action fails to present the required evidence of obviousness.

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 31.

31. Claim 32

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of the applied portions of the relied-upon references no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 32 in such a manner so as to arrive at the additional claimed subject matter of claim 32. Thus, the Office Action fails to present the required evidence of obviousness.

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 32.

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32. Claim 33

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of the applied portions of the relied-upon references no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 33 in such a manner so as to arrive at the additional claimed subject matter of claim 33. Thus, the Office Action fails to present the required evidence of obviousness.

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 33.

II. The Present Office Action Fails to Respond to All of Applicant's Arguments

A proper Office Action must be complete as to all matters, must provide a clear explanation of all actions taken, and must answer in detail the substance of each of Applicant's submitted arguments. *See MPEP 707.07(f)*.

In response to an Office Action dated 29 June 2006, Applicant filed a proper Reply on 5 June 2007, which is incorporated herein by reference. In traversing a rejection of each of claims 1-33, Applicant presented numerous arguments that stand unopposed in the present Office Action. For example, regarding claim 1, Applicant argued:

a. Prima Facie Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Lack of Evidence of Obviousness

Applicant respectfully notes that the present Office Action fails to evidence the scope and contents of the prior art as required under *Graham*.

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The present Office Action fails to even identify what "the pertinent art" is. Moreover, the present Office Action fails to evidence the level of ordinary skill in the pertinent art.

Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103. For at least these reasons, Applicant respectfully requests a reconsideration and withdrawal of the rejection of claim 1.

c. **Evidence of Obviousness – Combination of References**

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Slavin, Kolls, Valdes-Rodriguez, and Marshall, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 1, in such a manner so as to arrive at the claimed subject matter of claim 1. Regarding the proffered combination of Slavin, Kolls, Valdes-Rodriguez, and Marshall, the present Office Action states, at Pages 2-4:

1. "it would have been obvious to an ordinary skill in the art at the time the invention was made to modify a method for transmitting a signal from a non-telephonic wireless transmitter/transponder as disclosed by Slavin et al. to include the aspect of a signal is from a *vehicle-powered* non-telephonic wireless transmitter/transponder, as suggested by Kolls et al. to utilize a secure, uninterrupted, long-lasting power connection to the vehicle's battery";
2. "it would have been obvious to an ordinary skill in the art at the time the invention was made to modify a method for

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transmitting a signal from a *vehicle-powered* non-telephonic wireless transmitter/transponder as suggested by Slavin et al. in view of Kolls et al. to include the aspect of an *encrypted* unique identifier in the transmitted signal as taught by Valdes-Rodriguez to ensure secrecy of information or data during transmission"; and

3. "it would have been obvious to an ordinary skill in the art at the time the invention was made to modify a method for transmitting a signal from a *vehicle-powered* non-telephonic wireless transmitter/transponder as suggested by Slavin et al. in view of Kolls et al. further in view of Valdes-Rodriguez to include the aspect of the signal transmitted responsive to '*a predetermined input from a user* {claim 1}, *wherein such an input comprises a predetermined number of headlight high beam switch activations within a predetermined time interval*' {claim 6} as suggested by Marshall to activate a transmitter and get it ready to transmit signal/data to a receiver."

Applicant respectfully submits that these unsupported assertions provide no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence is presented that this unsupported assertion was "known in the prior art", as required by *KSR*. Applicant reiterates that under *KSR* "rejections on obviousness grounds cannot be sustained by mere conclusory statements". Thus, the Office Action fails to present the required evidence of obviousness.

d. **Marshall is Not Pertinent Art to the Claimed Subject Matter**

Marshall allegedly asserts, at the Abstract:

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[a]n illumination tool for projecting a light beam through a transparent structure that has a portion of the tool detachably securable via a vacuum seal mechanism that engages the transparent structure. A lighting mechanism is electrically attached to the illumination tool and is positioned in contact with the transparent structure via a soft seal positioned about the lighting mechanism. The lighting mechanism may, if desired, be manually activated and deactivated i.e., the illumination tool turned on or off. If desired, the illumination tool may be remotely operated by a user depressing a remote operating switch and a radio signal is communicated to the illumination tool. The remote actuator may also be hardwire connected to the illumination tool. Further, if desired the lighting mechanism may be illuminated via strobe light, a continuous or flashing beam of light.

Thus, Marshall relates to an "illumination tool".

By contrast, claim 1 recites "receiving an approval from the central processor to complete the proposed transaction, the proposed transaction involving the valid financial account associated with the unique identifier."

One skilled in the art at the time of the invention would not have found an "illumination tool" to be in the same field of endeavor as "receiving an approval from the central processor to complete the proposed transaction, the proposed transaction involving the valid financial account associated with the unique identifier."

Likewise, one skilled would not find "illumination tool" to be "reasonably pertinent to the particular problem with which the inventor was involved" in "receiving an approval from the central processor to

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complete the proposed transaction, the proposed transaction involving the valid financial account associated with the unique identifier.”

Further, because they are directed at vastly different problems, one of skill in the art would not consider Marshall to be pertinent art to that of Slavin, Kolls, and/or Valdes-Rodriguez.

Thus, Marshall is not pertinent to the present Application and is therefore not available as a reference for combination with Slavin, Kolls, and/or Valdes-Rodriguez.

e. Reasonable Expectation of Success

The Final Office Action attempts to, impermissibly, combine portions of Slavin, Kolls, Valdes-Rodriguez, and Marshall in rejecting the claimed subject matter.

Applicant respectfully reiterates that Marshall is allegedly directed to an “illumination tool”.

By contrast, Slavin is allegedly directed toward an “automatic toll collection system.” See Abstract.

In further contrast, Kolls’ Abstract allegedly recites an “in-vehicle device data communicates with Internet based data processing resources for the purpose of transacting e-mail, e-commerce, and e-business.”

Further, Valdes-Rodriguez allegedly states, at the Abstract, “device for automatically paying a toll for a vehicle passing through a toll booth.”

The Final Office Action presents no evidence that one having ordinary skill in the art would have had any expectation of success, let alone a reasonable expectation of success, in combining the applied portions of the relied-upon references. At most, the applied portions of the

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relied-upon references provide "only general guidance as to the particular form of the claimed invention or how to achieve it"

Thus, even if there were proper evidence of obviousness presented by the Office Action (an assumption that is respectfully traversed), and even if the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, expressly or inherently teach or suggest every limitation of claim 1 (another assumption that is respectfully traversed), there is still no evidence indicating a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action, and consequently, the Office Action fails to establish a *prima facie* case of obviousness.

f. Conclusion

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 1. Applicant also respectfully requests a withdrawal of each of claims 2-13, each ultimately depending from claim 1.

The present Office Action fails to respond whatsoever to these previously presented and persuasive arguments or any other arguments traversing the remaining rejections of each of claims 2-33. Instead, the present Office Action merely asserts, at Page 1, "Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection as follows." Applicant respectfully submits that the "arguments" that were presented are not, and were not, "moot". The substance of those arguments is indeed repeated herein. With the exception of an application of an impermissible and legally erroneous *per se* rule used as a part of the rejection of each of independent claims 1, 14, and 15, the present Office Action is a verbatim copy of the Office Action dated 29 June 2006.

Thus, Applicant respectfully requests the withdrawal of each of the rejections of claims 1-33.

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III. The Finality of the Office Action is Improper, Premature, and should be Withdrawn

Under MPEP 706.07(a) (emphasis added):

[u]nder present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

The present Office Action admits that a new ground of rejection is presented regarding each of independent claims 1, 14, and 15. See Pages 1, 2, 5, 6, 7, and 8. For example, regarding claim 1, the present Office Action states, at Page 2:

the USPTO interprets claim limitations that contain 'if, may, might, can, when and could' statement(s), as optional language. As matter of linguistic precision, optional claim elements *do not narrow claim limitations*, since *they can always be omitted* (*In re Johnston*, 77 USPQ2d 1788 (CA FC 2006)). Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does *not* limit the scope of a claim or claim limitation.

This new ground of rejection was neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). Thus, the present Office Action should not have been made final.

Moreover, a proper Office Action must be complete as to all matters, must provide a clear explanation of all actions taken, and must answer in detail the substance of each of Applicant's submitted arguments. *See* MPEP 707.07(f).

In response to an Office Action dated 29 June 2006, Applicant filed a proper Reply on 5 June 2007, which is incorporated herein by reference. In traversing a rejection of each of claims 1-33, Applicant presented numerous arguments that stand unopposed in the present Office

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Action. For example, regarding claim 1, Applicants arguments are cited, *supra*, in Section 2 of this Reply.

The present Office Action fails to respond whatsoever to these previously presented and persuasive arguments or any other arguments traversing the remaining rejections of each of claims 2-33. Instead, the present Office Action merely asserts, at Page 1, "Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection as follows." Applicant respectfully submits that the "arguments" that were presented are not, and were not, "moot". The substance of those arguments is indeed repeated herein. With the exception of an application of an impermissible and legally erroneous *per se* rule used as a part of the rejection of each of independent claims 1, 14, and 15, the present Office Action is a verbatim copy of the Office Action dated 29 June 2006.

For at least these reasons, Applicant respectfully submits that the finality of the 9 October 2007 Office Action is premature. Thus, Applicant respectfully requests that the finality of the 9 October 2007 Office Action be withdrawn.

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CONCLUSION

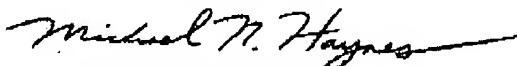
It is respectfully submitted that the application is in clear condition for allowance.

Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

Michael Haynes PLC



Date: 08 January 2008

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